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EXAMINER

BOSWELL, BETH V

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MIKE O'DONNELL and ANDREW CAMERON

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Appeal 2010-001885  
Application 09/245,798  
Technology Center 3600

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*Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 126 to 147. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). The Appellants appeared for oral argument on March 17, 2011.

We AFFIRM.

## BACKGROUND

Appellants' invention is directed to a method of obtaining licensing permission to use material created by another and to present assurances that permission was obtained for use (Spec. 1).

Claim 126 is illustrative:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work authorship.

Appellants appeal the following rejections:

Claims 126, 127, 129 to 131, 138, and 145 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson (US Pat. 5,991,876, iss. Nov. 23, 1999) in view of Official Notice.

Claims 128, 142, 146, and 147 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Elsevier Science (<http://www.web.archive.org/web/19970211230059/http://www.elsevier.com/>) (last visited Dec. 6, 2006) and Official Notice.

Claims 133 and 139 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Holmes (US Pat. 6,119,108, iss. Sep. 12, 2000).

Claims 136, 137, 143, and 144 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Elsevier Science and further in view of Holmes.

Claims 132, 134, 135, 140, and 141 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of DOI System Specification ([http://web.archive.org/web/20001028131418/www.doi.org/system\\_spec.html](http://web.archive.org/web/20001028131418/www.doi.org/system_spec.html)) (last visited Jan. 8, 2004) (hereinafter DOI). The following references relied on by the Examiner disclose aspects of DOI:

- i. Calvin Reid, STM houses, CCC showcase latest DOI prototype via AAP, *Publishers Weekly*, 12 (Sep. 29, 1997) (referred to by the Examiner as “reference A”);
- ii James Lichtenberg, *Metadata for the Millennium*, *Publishers Weekly*, 44 (Apr. 21, 1997) (referred to by the Examiner as “reference B”);
- iii. Calvin Reid, *AAP unveils DOI at PSP Confab: Publishers interested but wary*, *Publishers Weekly*, 11 (Feb. 24, 1997) (referred to by the Examiner as “reference C”); and
- iv *Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications*, *Information Intelligence, Online Libraries, and Microcomputers*, 8 (Oct. 1997) (referred to by the Examiner as “reference D”).

### ISSUE

Did the Examiner err in rejecting the claims because Johnson does not disclose sending an electronic copy of the first work of authorship as a consequence of acceptance of offered terms and request for copy?

### FACTUAL FINDINGS

We adopt the Examiner's findings in the Answer (Ans. 5 to 8). Additional findings of fact may appear in the Analysis that follows.

### ANALYSIS

We are not persuaded of error by Appellants' argument that Johnson does not disclose sending an electronic copy of the first work of authorship as a consequence of acceptance of offered terms and request for copy as is recited in claim 126. Claim 126 is rejected over Johnson in view of Official Notice. As such, the argument that Johnson alone does not disclose the recited claimed steps is not persuasive because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In this regard, the Examiner recognizes that Johnson does not disclose sending an electronic copy of the first work of authorship as a consequence of acceptance of offered terms and request for copy (Ans. 6). The Examiner relies on Official Notice that it is well-known to transmit a copy of a work to a user after he has secured rights to use such work, such as by electronic means so that the user may have a copy of the work for use (Ans. 7). The Appellants have not traversed the Examiner's Official Notice.

We are not persuaded of error by the Examiner by Appellants' argument that Johnson alone does not disclose making the record available for look-up by anyone from any computer on the publicly accessible network as is recited in claim 129. Claim 129 is rejected over Johnson in view of Official Notice. As such, as we stated above, the argument that Johnson does not disclose the recited claimed steps is not persuasive because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. In this regard, the Examiner recognizes that Johnson does not disclose making the record available for look-up by anyone from any computer on the publicly accessible network (Ans. 8). The Examiner relies on Official Notice that it is well-known in network security that the availability of a database to be accessed over a network is based on the security settings associated with such data (Ans. 7). The Appellants have not traversed the Examiner's Official Notice.

We are also not persuaded that Johnson teaches away from making the work accessible to anyone. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out by the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. *See U.S. v. Adams*, 383 U.S. 39, 52, 86 S.Ct. 708, 714, 15 L.Ed.2d 572 (1966) ("known disadvantages in old devices which would naturally discourage the search

for new inventions may be taken into account in determining obviousness"); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851, 105 S.Ct. 172, 83 L.Ed.2d 107 (1984) (the totality of a reference's teachings must be considered); *In re Spinnoble*, 405 F.2d 578, 587 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); *In re Caldwell*, 319 F.2d 254, 256 (CCPA 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant).

The Appellants have not directed our attention to a specific portion of Johnson that is believed to teach away from making the record available for look-up by anyone. The Appellants allege that Johnson teaches that only administrators have access to the records. We find to the contrary that Johnson teaches that rights-holders and potential licensees also have access to the records (col. 3, ll. 48 to 55). In any case, the Appellants have not directed out attention to a portion of Johnson that discourages making the record available to anyone and thus have not established that Johnson teaches away in this regard.

We are not persuaded of error by the Examiner by Appellants' argument that there is no suggestion or motivation to modify Johnson so as to make the record available for look-up by anyone from any computer on the publicly accessible network.

To the extent Appellants are looking for an explicit motivation, suggestion, or teaching in the art, this rigid test has been foreclosed by the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In *KSR*, the Court characterized the teaching, suggestion,



motivation test as a “helpful insight” but found that when it is rigidly applied, it is incompatible with the Court's precedents. *KSR*, 550 U.S. 398 at 418-19. The holding in *KSR* makes clear that it is no longer absolutely necessary to find motivation in the references themselves. *See KSR*, 550 U.S. 398 at 418-19. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

In the instant case, as a person of ordinary skill would have known that in network security the availability of a database to be accessed over a network is based on the security settings associated with such data. As such,

adjusting the security settings in the Johnson method would have been no more than the use of a known method to produce a predictable result and as such would have been obvious at the time of the invention.

In view of the foregoing, we will sustain the Examiner's rejection of claims 126 and 129. We will also sustain the rejection as it is directed to the remaining claims because the Appellants have not argued the patentability of these claims.

#### DECISION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1).

#### AFFIRMED

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